

REMARKS

Status of Application

Claims 23-43 are pending in the application and stand rejected. In view of the amendments presented above and the following remarks, applicant request reconsideration of the rejection of the Claims and reexamination of the application.

Terminal Disclaimer

Claims 23-43 are rejected under the judicially created doctrine of obviousness-type patenting as being unpatentable over claims 1-13 of US Patent No. 6,688,659 to Kobrehel. The '659 patent issued from US Patent Application Serial No. 10/008,302, which is a parent application to the present application. Applicants respectfully traverse the rejection on the grounds that the present claims are patentable over claims 1-13 of the '659 patent. Nevertheless, in order to expedite prosecution of the present application, applicant files herewith a Terminal Disclaimer. Specifically, a Terminal Disclaimer in compliance with 37 CFR 1.321(c) is filed to obviate the double patenting rejection. Accordingly, the rejection is deemed to be overcome.

Patentability of US Patent No. 3,083,419 to Pennington

Claims 23-25, 30,31 and 33 stand rejected under Section 102(b) over US 3,083,419 to Pennington. The rejection is respectfully traversed.

Pennington fails to disclose a window assembly comprising a pane, a latch bolt housing mounted to the pane, a latch bolt slidably mounted to the latch bolt housing, wherein the latch bolt is adapted for compound sliding movement in a plane substantial parallel to the pane, a biasing member operative to urge the latch bolt toward a first

position, and a release handle remote from the latch bolt. Accordingly, the rejection is in error and the rejection should be withdrawn.

In particular, Pennington notably fails to disclose a window assembly having a latch bolt adapted for compound sliding movement. The Examiner argues that recitation in a claim that an element is “adapted to” perform a function is not a positive limitation. Applicant respectfully disagrees. Controlling case law clearly gives patentable weight to claim limitations reciting that an element is adapted for or adapted to perform a function. See, for example, *Ishida Co. v. Taylor*, 221 F.3d 1310; 55 USPQ2d 1449 (Fed. Cir. 2000) construing claims to cover separate structures for performing stripping and sealing functions in means-plus-function limitation reciting “[a] pair of opposing sealing and stripping means... being **adapted to cooperate...**” (emphasis added). See also *McKewon v. Bayshore Concrete Products*, 34 Fed. APPX. 741 (Fed. Cir. 2002) holding that Plaintiff failed to raise a genuine issue of material fact as to whether Defendants products contain limitation of claim 1 elongated base portions having “a bottom surface **adapted to be mounted** on an existing roadway traffic surface” (emphasis added). Thus, the Federal Circuit not only endorses the use of “adapted to” limitations as positive limitations in patent claims, but has relied upon them in more than one case as the critical patent limitations in deciding the case.

Accordingly, the “adapted to” limitation in the present claims of the application should be given patentable weight.

As noted above, and giving patentable weight to the “adapted for” limitation in the present claims, the Pennington citation falls short of anticipating the window assembly defined by the claims. Pennington fall short for the reason, amongst others, that it fails to disclose a latch bolt adapted for compound sliding movement. The term “compound sliding movement” used in the present claims is expressly defined in the specification. Specifically, it is defined in paragraph [44] is defined as

An angular, serpentine or curvilinear movement, ...”

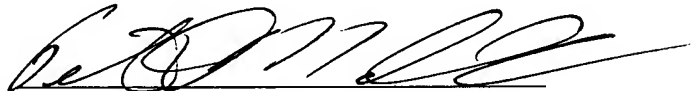
Pennington provides no disclosure of a window assembly having a latch bolt adapted for such compound sliding movement. As recognized by the Examiner, the Pennington window assembly is "explicably disclosed for a combination of linear rotary sliding motion." The linear motion of Pennington, either with or without rotary sliding motion, is neither angular, serpentine or curvilinear. Accordingly, the rejection is in error and should be withdrawn.

IV. Conclusion

In view of the foregoing remarks, all claims pending in the application are seen to be condition for allowance which action is earnestly requested.

Respectfully submitted,
Kobrehel

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Peter D. McDermott (Reg. No. 29,411)
Attorney for Applicants
Banner & Witcoff, LTD.
28 State St. - 28th Floor
Boston, MA 02109
617.720.9600